

REMARKS

Applicant thanks examiner Paulraj for correcting the omitted claim number 68 in the preliminary amendment, by renumbering of Claims 69-73 as 68-72 in the Office Action mailed November 29, 2002. [Paper 3].

The present application has been amended to specify the type of priority of the present application and the status of the parent application, now U.S. Patent No. 6,406,785.

Statutory Double Patenting

Claims 37, 39, 42-45, 47-50, 52-54, 56-60, 62-68 and 70-72

Claims 37, 39, 42-45, 47-50, 52-54, 56-60, 62-68 and 70-72 stand rejected under 35 U.S.C. §101 as claiming the same invention of Claims 1-30 of U.S. Patent No. 6,406,785.

Applicant respectfully submits the claims of U.S. Patent No. 6,406,785, as shown in the enclosed Certificate of Correction filed in US Patent 6,406,785, and shown by the prosecution history of the '785 patent are directed to *cross linked* UHMW polyethylene particles (Claims 1-3); *cross linked* UHMW polyolefin particles (Claim 4); surface treated thermoplastic *cross linked* particles (Claims 5-8); *cross linked* surface treated olefinic particles (Claims 9-15); surface treated, *cross linked* olefinic particles (Claim 16); *cross linked* surface treated olefinic particles (Claims 17-23); and surface treated, *cross linked* olefinic particles (Claims 23-30). [emphasis added]

In contrast, the present claims recite particles which are not cross linked. Specifically,

"UHMW polyethylene particles having a polar functional group" (Claims 37-39); "surface treated UHMW polyolefin particles" (Claims 40-41); "surface treated thermoplastic particles" (Claims 42-46); "surface treated olefinic particles" (Claims 47-55); "surface treated olefinic particles" (Claim 56); and "surface treated olefinic particles" (Claims 57-64); "surface treated olefinic particles" (Claims 65-72).

Therefore, the present claims are not claiming the same invention as U.S. Patent No. 6,406,785 and thus applicant requests the statutory double patenting rejection be withdrawn.

Non Statutory Double Patenting

Claims 38, 40, 46 and 55

Claims 38, 40, 46 and 55 stand rejected under the judicially created doctrine of obviousness-type double patenting.

In view of the distinction between the present claims and the claims of US Patent No. 6,406,785, applicant respectfully submits Claims 38, 40, 46 and 55 are patentably distinct from the claims of US Patent No. 6,406,785. However, if the nonstatutory double patenting rejection is maintained, upon the remaining rejections being addressed, a terminal disclaimer will be filed.

Rejections under 35 U.S.C. §112

Claims 41, 51, 52, 61 and 69

Claims 41, 51, 52, 61 and 69 stand rejected under 35 U.S.C. §112, first paragraph. Specifically, the examiner asserts the specification does not disclose the concept that the olefinic particles themselves are cross linked or that the olefinic particles are sufficiently bonded to the cured thermoset base carrier to substantially preclude non destructive separation. [Paper 3, Page 4]

The present application is a divisional of U.S. 09/388,094 filed June 23, 1999. As filed, the '094 application recited in Claim 5, "the ultra high molecular weight polyolefin particle is cross linked" and in Claim 15, "the surface treated olefinic particles are cross linked." Therefore, applicant respectfully submits this subject matter was described in the specification in compliance with 35 U.S.C. §112 in the parent application. The present specification has been amended to include a recitation of this disclosure.

Claim 52 has been amended to remove the terms "non-destructive" and "substantially." The remaining claims rejected under 35 U.S.C. 112, have been amended to address the outstanding rejections and are believed in condition for allowance.

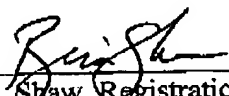
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Therefore, applicant respectfully submits all the pending claims, Claims 37-83 are in condition for allowance, and such action is earnestly solicited. If, however, the examiner believes any further issues remain, he is cordially invited to call the undersigned so that such matters can be promptly resolved.

Respectfully submitted,



Brian B. Shaw, Registration No. 33,782
HARTER, SECREST & EMERY LLP
1600 Bausch & Lomb Place
Rochester, New York 14604

Date: February 28, 2003

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gopalan, Krishnamachari et al. Atty. Docket: 85939.000018
Serial No.: 09/338,094 Patent No. 6,406,785 B1
Filed: June 23, 1999 Date of Patent: June 18, 2002
Title: WEATHERSEAL HAVING A CONTACT LAYER WITH THERMOPLASTIC
PARTICLES IN A THERMOSET CARRIER

Certificate of Correction Under 35 U.S.C. § 254, 37 C.F.R. § 1.322

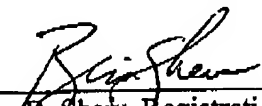
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant encloses form PTO/SB/44, a Certificate of Correction, for the above-referenced United States patent, which issued June 18, 2002.

As the error occurred through a mistake in the United States Patent and Trademark Office, applicant respectfully submits no fee is due at this time. Specifically, in Paper 9, an extension of time for one month was requested for entry of the Examiner's Amendment, which incorporated the Amendment After Final mailed August 22, 2001, and the examiner's amendment to the claims of the Amendment After Final.

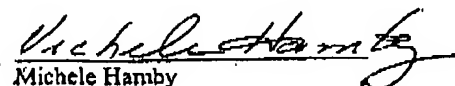
Respectfully submitted,



Brian B. Shaw, Registration No. 33,782
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Date: February 24, 2003

I certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on February 24, 2003.



Michele Hamby

PTO/SB/44 (02-01)

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**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

Page 1 of 6

PATENT NO :US 6,406,785 B1

DATED :June 18, 2002

INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
Krishnamachari Gopalan

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published Claims 1 through 30, replace with the following Claims 1- through 30:

- 1. A weatherseal for releasably contacting a panel, comprising:
 - (a) a substrate; and
 - (b) a contact layer on at least a portion of the substrate, the contact layer including a thermoset carrier and a multitude of cross linked UHMW polyethylene particles having a polar functional group, the UHMW polyethylene particles chemically bonded to the thermoset carrier to form surface projections.
- 2. The weatherseal of Claim 1, wherein the thermoset carrier includes cross linkable urethane.
- 3. The weatherseal of Claim 1, wherein the substrate includes one of an EPDM, a thermoplastic and a thermoplastic elastomer.
- 4. A weatherseal, comprising:
 - (a) a substrate including one of an EPDM, a thermoplastic and a thermoplastic elastomer; and
 - (b) a contact layer on the substrate, the contact layer including surface treated cross linked UHMW polyolefin particles in a cross linked urethane based carrier, the surface treated UHMW polyolefin particles forming projections.

MAILING ADDRESS OF SENDER

Harter, Secrest & Emery LLP
1600 Bausch and Lomb Place
Rochester, New York 14604-2711

PATENT NO. U.S. 6,406,785 B1

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**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

Page 2 of 6

PATENT NO :US 6,406,785 B1
DATED :June 18, 2002
INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
Krishnamachari Gopalan

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published claims 1 through 30, replace with the following claims 1- through 30:

5. A contact layer for a weatherseal, comprising a multitude of surface treated thermoplastic cross linked particles bonded to a curable carrier; the surface treated thermoplastic particles creating a reduced coefficient of friction of the contact layer.
6. The contact layer of Claim 5, wherein the thermoplastic surface treated particles are an ultra high molecular weight olefin.
7. The contact layer of Claim 5, wherein the thermoplastic surface treated particles are surface treated UHMW polyethylene.
8. The contact layer of Claim 5, wherein the carrier includes urethane.
9. A weatherseal, comprising:
 - (a) a substrate; and
 - (b) a contact layer on a portion of the substrate, the contact layer having a multitude of cross linked surface treated olefinic particles in a cured thermoset urethane based carrier, the surface treated olefinic particles sized to create surface projections in the contact layer.

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Page 3 of 6

PATENT NO :US 6,406,785 B1
DATED :June 18, 2002
INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
Krishnamachari Gopalan

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published claims 1 through 30, replace with the following claims 1- through 30:

10. The weatherseal of Claim 9, wherein the substrate includes one of an EPDM, a thermoplastic and a thermoplastic elastomer.

11. The weatherseal of Claim 9, wherein the surface treated olefinic particles are UHMW polyethylene.

12. The weatherseal of Claim 9, wherein the surface treated olefinic particles are chemically bonded to the cured thermoset urethane based carrier.

13. The weatherseal of Claim 9, wherein the surface treated olefinic particles are sufficiently bonded to the carrier to substantially preclude separation.

14. The weatherseal of Claim 9, wherein the surface treated olefinic particles are encapsulated within the carrier.

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1800 Bausch and Lomb Place
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**UNITED STATES PATENT AND TRADEMARK OFFICE
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Page 4 of 6

PATENT NO :US 6,406,785 B1
DATED :June 18, 2002
INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
Krishnamachari Gopalan

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published claims 1 through 30, replace with the following claims 1- through 30:

15. The weatherseal of Claim 9, wherein the surface treated olefinic particles have a polar functional group.
16. A method of forming a weatherseal, comprising:
- (a) forming a substrate;
 - (b) mixing a multitude of surface treated, cross linked olefinic particles and a curable thermoset urethane based carrier;
 - (c) disposing the mixed surface treated olefinic particles and the curable thermoset urethane based carrier on a portion of the substrate; and
 - (d) curing the curable thermoset urethane based carrier as it is disposed on the substrate to retain discrete surface treated olefinic particles and form surface projections.
17. A Weatherseal, comprising:
- (a) a substrate; and
 - (b) a contact layer on a portion of the substrate, the contact layer having a multitude of cross linked surface treated olefinic particles in a cured thermoset urethane based carrier, the surface treated olefinic particles having a melting temperature greater than a curing temperature of the urethane based carrier.

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UNITED STATES PATENT AND TRADEMARK OFFICE
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PATENT NO :US 6,406,785 B1
DATED :June 18, 2002
INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
 Krishnamachari Gopalan

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published claims 1 through 30, replace with the following claims 1- through 30:

18. The weatherseal of Claim 17, wherein the substrate includes one of an EPDM, a thermoplastic and a thermoplastic elastomer.
19. The weatherseal of Claim 17, wherein the surface treated olefinic particles are UHMW polyethylene.
20. The weatherseal of Claim 17, wherein the surface treated olefinic particles are chemically bonded to the cured thermoset urethane based carrier.
21. The weatherseal of Claim 17, wherein the surface treated olefinic particles are sufficiently bonded to the carrier to substantially preclude separation.
22. The weatherseal of Claim 17, wherein the surface treated olefinic particles are encapsulated within the carrier.
23. The weatherseal of Claim 17, wherein the surface treated olefinic particles have a polar functional group.
24. A weatherseal, comprising:
 - (a) a substrate; and
 - (b) a contact layer on a portion of the substrate, the contact layer having a multitude of surface treated, cross linked olefinic particles in a cured thermoset carrier, the surface treated, cross linked olefinic particles having a melting temperature greater than a curing temperature of the thermoset carrier.

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Page 6 of 6

PATENT NO :US 6,406,785 B1
DATED :June 18, 2002
INVENTOR(S) :Dennis W. Janes, Jason O. Watts, Kevin Dale Utterback,
Krishnamachari Gopalan

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In place of published claims 1 through 30, replace with the following claims 1- through 30:

25. The weatherseal of Claim 24, wherein the substrate includes one of an EPDM, a thermoplastic and a thermoplastic elastomer.
26. The weatherseal of Claim 24, wherein the surface treated olefinic particles are UHMW polyethylene.
27. The weatherseal of Claim 24, wherein the surface treated olefinic particles are chemically bonded to the cured thermoset urethane based carrier.
28. The weatherseal of Claim 24, wherein the surface treated olefinic particles are sufficiently bonded to the carrier to substantially preclude separation.
29. The weatherseal of Claim 24, wherein the surface treated olefinic particles are encapsulated within the carrier.
30. The weatherseal of Claim 24, wherein the surface treated olefinic particles have a polar functional group. —

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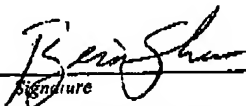

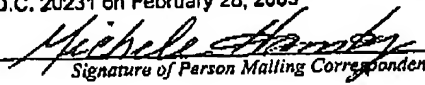
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| AMENDMENT TRANSMITTAL | | | | <input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity | |
| Applicant(s): Gopalan, Krishnamachari | | | | Docket No. 85939.000217 | |
| Serial No. | Filing Date | Examiner | Group Art Unit | | |
| 10/060,501 | January 30, 2000 | Christopher Paulraj | 1773 | | |
| Invention: WEATHERSEAL HAVING A CONTACT LAYER WITH THERMOPLASTIC PARTICLES IN A THERMOSET CARRIER | | | | | |
| TO THE ASSISTANT COMMISSIONER FOR PATENTS: | | | | | |
| Transmitted herewith is an amendment in the above-identified application. | | | | | |
| The fee has been calculated and is transmitted as shown below. | | | | | |
| CLAIMS AS AMENDED | | | | | |
| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST # PREV. PAID FOR | NUMBER EXTRA CLAIMS PRESENT | RATE | ADDITIONAL FEE |
| TOTAL CLAIMS | 47 | 36 | 11 | X 18.00 | \$198.00 |
| INDEP. CLAIMS | 7 | 7 | 0 | X 84.0 | \$ |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> | | | | | \$ |
| If small entity status, reduce by 50% | | | | | \$ |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | \$198.00 |
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|  Brian B. Shaw, Reg. No. 33,782 | | | | Dated: February 28, 2003 | |
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ATTORNEYS AND COUNSELORS
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February 28, 2003

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| Examiner Paulraj | USPTO Washington, D.C. | 703-308-1036 | 703-872-9310 |

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